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Remarks:

*Regarding the objection to claim 8:*

The applicant's amendment to claim 8 in this paper is believed to fully address and overcome the Examiner's grounds of rejection.

*Regarding the provisional "double patenting" rejection of claims 1-8, and claims 11-12 in view of copending application US Serial No. 10/597448:*

Applicants respectfully traverse the Examiner's "double patenting" rejection of the foregoing claims in view of copending U.S. Application No. 10/597448 (hereinafter "the copending 448 application") which is commonly assigned with the present application. Applicants point out that to date, no claims in the instant application or the 448 application have been cited as being allowable. Furthermore, the applicant points out that in this present paper, the scope of the independent claim has been amended, which may provide a basis for the withdrawal of the present "double patenting" rejection in light of the current claims of US Serial No. 10/597448. As such it is thus believed that the Examiner's issuance of a "double patenting" rejection is improper and/or as being premature. Applicants believe that entry of a Terminal Disclaimer at this point in time is premature, as the scope of allowable claims in the present application have not yet been established agreeing to the limitation of the term and scope of protection may be prejudicial to the rights of the applicant, e.g., wherein narrowed claims of the present application may be indicated as allowable and such claims might no longer give basis to a "double patenting" rejection. However, upon the indication of allowable subject matter, the Examiner is invited to reinstate the instant rejection, if appropriate, at such later time.

*Regarding the rejection of claims 1-8, and 11-12 under 35 USC 112, 1<sup>st</sup> paragraph:*

The applicant's presently amended claims are believed to address and overcome the Examiner's grounds of rejection.

The applicant first points out that claims 11 and 12 have been canceled in this paper, thus rendering the rejection of those claims as moot.

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The applicant next points out that the claims have been amended to now specifically recite "A method of reducing the amount of a Der p 1 ~~deactivating an allergen on an inanimate surface~~, ..." which amended claim cancels the objected to terms of the claim, namely "deactivate" and "allergens". Now, the claim recites the specific process steps of "reducing the amount of" the "Der p 1" allergen which is fully supported by the applicant's specification as filed. The several examples of the specification clearly demonstrate that the amount of the Der p1 allergen was reduced, as reported by the ELISA (enzyme linked immunoabsorbent assay) test, when an allergen-reducing material (see claim 1) was provided to the airspace within which the tested substrate was present.

The applicant notes that new claims 13 – 15 are also being presented in this paper, which more specifically define the use of a "candle" or an "oil burner" as the device for the delivery of the allergen-reducing material; such devices find *ipsis verbis* support in the various examples of the instant patent specification.

The applicant objects to the Examiner's assertion that the applicant's claimed invention is insufficiently enabling under the factors of *In re Wands* 858 F.2d 731 (Fed.Cir. 1988), notably "the scope of the claim, the amount of direction or guidance, the lack of sufficient working examples, the unpredictability in the art and the amount of experimentation required to enable one of skill in the art to practice the claimed invention."

The Examiner is respectfully reminded that all that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a "reasonable correlation" to the scope of the claims. See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). How a teaching is set forth, by specific example or broad terminology, is not important. *In re Marzocchi*, 439 F.2d 220, 223-24 169 USPQ 367, 370 (CCPA 1971).

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One does not look to the claims but to the specification to find out how to practice the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558, 220 USPQ 303, 316-17 (Fed. Cir. 1983); *In re Johnson*, 558 F.2d 1008, 1017, 194 USPQ 187, 195 (CCPA 1977). In *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976), the court stated: "[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts."

When analyzing the enabled scope of a claim, the teachings of the specification must not be ignored because claims are to be given their broadest reasonable interpretation that is consistent with the specification. "That claims are interpreted in light of the specification does not mean that everything in the specification must be read into the claims."

*Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957, 220 USPQ 592, 597 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984).

The quantity of experimentation needed to be performed by one skilled in the art is only one factor involved in determining whether "undue experimentation" is required to make and use the invention. "[A]n extended period of experimentation may not be undue if the skilled artisan is given sufficient direction or guidance." *In re Colianni*, 561 F.2d 220, 224, 195 USPQ 150, 153 (CCPA 1977). "The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed." *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (citing *In re Angstadt*, 537 F.2d 489, 502-04, 190 USPQ 214, 217-19 (CCPA 1976)). Time and expense are merely factors in this consideration and are not the controlling factors. *United States v. Telectronics Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989). In *United States v. Telectronics, Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir.

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1988), *cert. denied*, 490 U.S. 1046 (1989), the court reversed the findings of the district court for lack of clear and convincing proof that undue experimentation was needed. The court ruled that since one embodiment (stainless steel electrodes) and the method to determine dose/response was set forth in the specification, the specification was enabling. The question of time and expense of such studies, approximately \$50,000 and 6-12 months standing alone, failed to show undue experimentation. Here, in the instant application, the various examples demonstrate specific processes wherein "reducing the amount of" the "Der p 1" allergen was achieved, according to the test protocols described and as substantiated by the results reported by the ELISA (enzyme linked immunoabsorbent assay) test, when an allergen-reducing material (see claim 1) was provided to the airspace within which the tested substrate was present. The applicant's specification recites with particularity specific test protocols which can be easily reproduced to evaluate the efficacy of any of the one or more, albeit limited list, of the recited allergen-reducing materials in reducing the Der p1 allergen which may be presenting house dust on an inanimate surface; see claim 1. The applicant's specification, and the amended claims presented in this paper, are believed to be fully compliant with and satisfy the factors outlined in *In re Wands* 858 F.2d 731 (Fed.Cir. 1988).

In view of the amended claims presented in this paper, and in further view of the accompanying remarks presented *supra*, withdrawal of all grounds of rejection is solicited.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

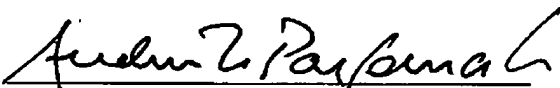
The early issuance of a *Notice of Allowability* is solicited.

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**CONDITIONAL AUTHORIZATION FOR FEES**

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, including any extension of time fees, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;



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10 August 2010  
Date:

**CERTIFICATION OF TELEFAX TRANSMISSION:**

I hereby certify that this paper and all attachments thereto is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571 273-8300 on the date shown below:

  
Allyson Ross

10 August 2010  
Date:

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